

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed October 4, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 112, First Paragraph

Claims 22, 32, 39, 42, and 48-50 have been rejected under 35 U.S.C. § 112, first paragraph, for lacking enablement. In particular regard to claims 22, 32, 39, and 42, it is argued that the recitation “discovering devices on a network that are not directly connected to a computer” is not enabled. Applicant disagrees.

In regard to the above-noted recitation, Applicant asserts that the originally-filed specification provides ample support and enablement for “discovering devices on a network that are not directly connected to a computer”. Regarding the phrase “discovering devices on a network”, Applicant notes that support may be found at least on page 1, lines 6-8; page 3, line 24 to page 4, line 5; page 4, lines 12-14; page 14, lines 5-13 and 16-17; and page 17, lines 1-5. In those portions of Applicant’s original specification, Applicant describes “recognizing” or “discovering” devices connected in a “distributed processing environment.” Moreover, it is clear from those portions that the “distributed processing environment” comprises a network. For example, Applicant states the following on pages 3 and 4:

The system for recognizing devices connected in a distributed processing environment can be implemented in software (e.g., firmware), hardware, or a combination thereof. In one embodiment, the system for

recognizing devices connected in a distributed processing environment is implemented in a configuration in which a plurality of devices are coupled to a network and the user of the system uses a computer, such as a personal computer (PC) to access the connected devices, and in which the invention is implemented using primarily software.

[Applicant's specification, page 3, line 25 to page 4, line 5]

In addition, an embodiment of the discovery process is described on page 14, which provides:

The discovery element 358 is a software component that can discover the presence of all types of devices coupled to the network 340. For example, the discovery element 358 can query all devices on the network by performing simply network management protocol (SNMP) queries for IP addresses in order to discover, for example, but not limited to, first printer 320 and second printer 330.

[Applicant's specification, page 14, lines 6-10]

Therefore, a disclosure as to how to "make and use" the claimed invention has been explicitly provided.

Furthermore, the phrase "that are not directly connected to a computer" is clearly supported by the specification as a whole, in which the only form of "discovery" is the discovery of devices that are directly connected to a network or, stated otherwise, not directly connected to a computer. The fact that the above-described discovery process comprises SNMP queries for IP addresses supports this fact. Regardless, to remove any question as to enablement, Applicant has amended claims 22, 32, 39, and 42 to clarify that the discovered devices are "directly connected" to a network.

In view of at least the foregoing, Applicant respectfully submits that the recitation “discovering devices on a network that are not directly connected to a computer” is enabled by the original specification. Applicant therefore respectfully requests that the rejection of claims 22, 32, 39, and 42 under 35 U.S.C. § 112, first paragraph, be withdrawn. Claims 48-50 have been canceled through this Response. As such, the rejection is deemed moot as to those claims.

II. Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claim 39 has been rejected under 35 U.S.C. § 112, second paragraph, for lacking antecedent basis for the term “the locations”. In response to the rejection, Applicant has amended claim 39 to merely recite “locations”. In view of that amendment, Applicant respectfully submits that claim 39 describes the invention in the manner required by 35 U.S.C. § 112, second paragraph, and requests that the rejection be withdrawn.

III. Claim Rejections - 35 U.S.C. § 102(e)

Claims 22-26, 29-37, 42, 43, and 45-50 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Goshey, et al. (“Goshey,” U.S. Pat. No. 6,327,613). Applicant respectfully traverses this rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the Goshey reference. Applicant discusses the Goshey reference and Applicant's claims in the following.

A. The Goshey Disclosure

Goshey discloses a method and apparatus for sharing peripheral devices over a network. Goshey, Patent Title. As is described by Goshey, a system is envisioned in which a plurality of computers (e.g., 112a, 112b, and 112d) connected to a network 110 comprise external peripheral devices that are directly connected thereto. Goshey, column 4, lines 31-36. Each of the computers 112 is provided with software code that enables other computers connected to the network to use the peripheral devices that are connected to the computers. Goshey, column 4, line 67 to column 5, line 5. In this manner, a first computer (e.g., 112d) may access and use a peripheral device directly connected to a second computer (e.g., 112b).

A specific example of the above functionality is provided in column 5. As is described by Goshey:

By way of example, if the Server (S) ScanLAN code is loaded onto computer 112b, and the Client (C) ScanLAN code is loaded onto computer 112d, then the user of computer 112d may be granted access privileges to the peripheral devices connected to computer 112b (which runs as a Server). Alternatively, each one of computers 112b and 112d may be loaded with both the Server and the Client ScanLAN code, which will therefore enable other users connected to the network to access the peripheral devices

connected to both computer 112b and computer 112d, when they are running as a Server.

[Goshey, column 5, lines 25-35]

From the above, it is clear that Goshey provides a system in which remote peripheral devices may be accessed and used *if* they are connected to a computer that is connected to the network and that comprises Goshey's "ScanLan" code.

B. Applicant's Claims

As is noted above, Goshey fails to teach several of Applicant's claim limitations. Applicant discusses some of those claim limitations in the following.

1. Claims 22-26, 29-31

Applicant's claim 22 provides as follows (emphasis added):

22. A method, comprising:
discovering devices directly connected to a network that are not directly connected to a computer; and
providing to a user via a network browser a list of at least one device that is available for use on the network, wherein the list comprises at least one link to an available device.

Applicant notes that, as is described above, Goshey's system is described, and only described, as facilitating access to peripheral devices that are directly connected to a computer that comprises "ScanLan" code that enables peripheral device sharing. Accordingly, Goshey does not teach a method comprising "discovering devices *directly*

connected a network that are not directly connected to a computer”, as is now recited in claim 22.

At least in view of the above, Applicant respectfully submits that Goshey does not anticipate claim 22, or the claims that depend therefrom. Applicant therefore respectfully requests that the rejections against these claims be withdrawn.

2. Claims 32-37

Applicant’s claim 32 provides as follows (emphasis added):

32. A device discovery service stored on a computer-readable medium, the service comprising:

logic configured to discover devices directly connected to a network that are not directly connected to a computer; and

logic configured to provide a user home service accessible with a network browser with a list of at least one device that is available for use on the network.

Regarding claim 32, Goshey at least does not teach “logic configured to discover devices *directly connected to a network that are not directly connected to a computer*”, at least for reasons discussed in relation to claim 22. Applicant respectfully submits that Goshey therefore does not anticipate claim 32 and its dependents, and respectfully requests that the rejections against these claims be withdrawn.

3. Claims 42, 43, and 45-47

Applicant's claim 42 provides as follows (emphasis added):

42. A system, comprising:

*means for discovering devices directly connected to a network
that are not directly connected to a computer;*

means for querying the means for discovering to receive a list of
discovered devices;

means for creating links to the discovered devices; and

means for providing the links to a user in a network browser for
selection.

Regarding claim 42, Goshey does not teach “means for discovering devices *directly connected to a network that are not directly connected to a computer*”, at least for reasons discussed in relation to claim 22. Applicant respectfully submits that Goshey therefore does not anticipate claim 42 and its dependents, and respectfully requests that the rejections against these claims be withdrawn.

C. Conclusion

Due to the shortcomings of the Goshey reference described in the foregoing, Applicant respectfully asserts that Goshey does not anticipate Applicant's claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

III. Claim Rejections - 35 U.S.C. § 103(a)

Claims 27, 28, 38-41, and 44 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Goshey in view of Carcerano, et al. (“Carcerano,” U.S. Pat. No. 6,308,205). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant’s disclosure.

In the present case, the prior art at least does not teach or suggest all of the claim limitations.

As is identified above, Goshey does not teach explicit limitations of Applicant's claims. In that Carcerano does not remedy the deficiencies of the Goshey reference, Applicant respectfully submits that claims 27, 28, 38-41, and 44 are allowable over the Goshey/Carcerano combination for at least the same reasons that Applicant's other claims are allowable over Goshey.

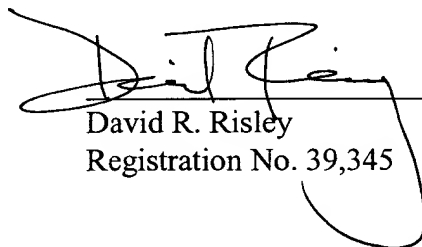
IV. Canceled Claims

Claims 1-21 and 48-50 have been canceled from the application without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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